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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,824	03/22/2001	Bert Vogelstein	01107.00112	8421
22907	7590	01/25/2005	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			MARTINELL, JAMES	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/813,824

Applicant(s)

VOGELSTEIN ET AL.

Examiner

James Martinell

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213. /

### Disposition of Claims

- 4) ☒ Claim(s) 14, 19-21 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 19-21 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/22/01</u> . | 6) <input type="checkbox"/> Other: ____  |

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The allowability of claims 14, 19-21, and 42 is withdrawn.

The disclosure is objected to because of the following informalities.

- (a) The instant application does not comply with the Sequence Rules (*i.e.* 37 CFR §§ 1.821-1.825). The sequence at page 17, line 9 is not identified with a SEQ ID NO as is required by 37 CFR § 1.821(d) (see also, MPEP 2422). The sequence cannot be SEQ ID NO: 1, nucleotides 105-125 (see page 17, lines 10-11) because the sequence is only 11 nucleotides in length.
- (b) Figures 10A, 10B, 10C, and 10D are not specifically mentioned in the Brief Description of the Drawings (see the specification, page 8, first full paragraph).
- (c) The application does not comply with the Sequence Rules (37 CFR §§ 1.821-1.825). In regard to the Sequence Listing filed March 22, 2001: (1) SEQ ID NO: 36 is indicated to be 5 nucleotides in length while the sequence recited is 25 nucleotides in length and (2) SEQ ID NO: 39 is indicated to be 5 nucleotides in length while the sequence recited is 10 nucleotides in length. See also MPEP 2420-2430.

Appropriate correction is required.

The reference, Romano et al, Oncogene 4: 1483 (1989) has not been considered because no copy has been found in the parent files and because a copy is not readily available to the USPTO.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 19-21, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The recitation of "the physiological effect of wild-type p53 protein" (claims 14, 19, and 42) is vague, indefinite, and incomplete because no particular physiological effect of p53 is mentioned.

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- (b) The recitation of "as well as sequences adjacent to said monomer sequence in the human genome" (claim 19) is vague and indefinite because neither the claims nor the instant application mention the size of the sequences adjacent to the monomer that are intended to be embraced by the claims. In addition, no such sequences are identified by nucleotide sequence or any other characteristic. The claim is also incomplete because there is no antecedent basis for the phrase in the specification. Finally, it is not understood what is meant by "the human genome" because there is no art-recognized meaning for the term in the sense of any particular nucleotide sequence.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant application does not provide an adequate written description for "sequences adjacent to said monomer sequence in the human genome". There is no disclosure of the use of any genomic sequences adjacent to the monomer sequence in the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. Only documents such as those intended for use in a personal or telephone interview should be faxed to the examiner's desktop workstation. Any Official Communication to the USPTO should be faxed to (571) 273-8300.

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The examiner works a flexible schedule and can be reached by phone and voice mail.

Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (571) 272-0745.


#### OFFICIAL FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
**James Martinell, Ph.D.**  
**Primary Examiner**  
**Art Unit 1634**

1/21/05